

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FELIX THEEUWES,
MICHEL J. N. CORMIER
and ARMAND P. NEUKERMANS

Appeal No. 2003-1778
Application No. 08/988,292

ON BRIEF

MAILED

NOV 24 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before LIEBERMAN, KRATZ and TIMM, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-5, 8, 10-12, 14, 15, 18-21, 28 and 29. Claims 23-27 and 30 have been indicated as allowable by the examiner. Claims 6, 7, 13, 16 and 17, which are all of the other claims pending in this application, have been indicated as allowable by the examiner but are objected to as depending from a rejected base claim.

BACKGROUND

Appellants' invention relates to a device for introducing or withdrawing an agent through a body surface. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A device for introducing or withdrawing an agent through a body surface, comprising:
 - a member having a body-surface proximal side and a body-surface-distal side; - said member further having a first surface on the body-surface-proximal side of the member, a second surface on the body-surface-distal side of the member and a plurality of protrusions capable of piercing said body surface; said protrusions extending from the first surface; and
 - a connecting medium disposed on at least a portion of the first surface of the member, said connecting medium capable of storing the agent therein or passing the agent therethrough when the plurality of protrusions have pierced the body surface and said connecting medium is placed in contact with said body surface.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lerner et al. (Lerner)	2,922,425	Jan. 26, 1960
Gerstel et al. (Gerstel)	3,964,482	Jun. 22, 1976
Kellett et al. (Kellett)	5,261,426	Nov. 16, 1993

Claims 1-5, 10, 11, 14, 15, 18-20, 28 and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lerner. Claims 1, 8, 10, 11 and 18-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kellett. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lerner in view of Gerstel.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

Upon consideration of the respective positions advanced by appellants and the examiner with respect to the rejections that are before us for review, we find ourselves in agreement with the examiner that each of Kellett and Lerner furnish sufficient evidence to make out a prima facie case of anticipation. However, we agree with appellants' position in so far as the examiner has failed to carry the burden of establishing a prima facie case of obviousness of the subject matter of claim 12. Accordingly, we affirm the examiner's § 102(b) rejections but reverse the examiner's stated § 103(a) rejection.

As our initial inquiry into a review of the examiner's rejections, we must analyze the claimed language to determine the

scope and meaning of each contested limitation. See Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). During prosecution of a patent application, the terms in a claim are given their broadest reasonable interpretation consistent with the specification. In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). Although no limitations in the specification is normally imputed to the claims being interpreted, see In re Paulsen, 30 F.3d at 1480, 31 USPQ2d at 1674, the specification can still be used to impart the meaning of words in the claims, see In re Barr, 444 F.2d 588, 593, 170 USPQ 330, 335 (CCPA 1971). After all, it is well established that appellants can be their own lexicographer so long as terms are clearly defined and not given meanings repugnant or abhorrent to the ordinary meaning. Here,, we observe that the term "body surface," as employed in the claims, is defined at page 7, lines 21-23 of the specification as follows:

The term "body surface" as used herein refers generally to the skin, mucous membranes and nails of an animal or human, and to the outer surface of a plant.

Consequently, we shall employ that definition of "body surface" as furnished by appellants in their specification in

assessing the propriety of the examiner's rejections of the claimed subject matter.

Rejections under 35 U.S.C. § 102(b)

Appellants indicate that the appealed claims stand or fall together (brief, page 3). Accordingly, we select claim 1 as the representative claim on which we shall decide this appeal as to the examiner's § 102(b) rejections. See 37 CFR § 1.192(c)(7)(2000).

Anticipation by a prior art reference does not require that the reference recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). However, the law of anticipation does not require that the reference teach what the appellants teach in their specification, but only that the claims

on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Anticipation under this section is a factual determination. See In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)). In the case before us, the examiner has determined that either Lerner or Kellett discloses, expressly or inherently, a device meeting every limitation of the invention set forth in representative appealed claim 1.

Considering appealed claim 1, we observe that appellants do not specifically contest or focus on the examiner's determination that each of Lerner (applicator elements 12 and 16, including 32) or Kellett (hair styling brush elements 6 and 1) describe devices that include structure corresponding to the member with surfaces and a connecting medium specified in representative claim 1. Rather, appellants' arguments center on the contention that the devices of Lerner or Kellett do not disclose a plurality of protrusions capable of piercing a body surface, keeping in mind appellants' definition of "body surface," as reproduced above.

On the other hand, the examiner makes reference to members (14, fig. 2) of Lerner and tines (5, fig. 2) of Kellett and argues that those elements correspond to appellants' claimed protrusions and would be capable of piercing a body surface. According to the examiner (answer, page 5), appellants' "body surface" definition includes, inter alia, surfaces of plants, which plant surfaces the protrusion members (14) of Lerner or the protruding tines (5) of Kellett are capable of piercing.

We are cognizant that Lerner is directed to an applicator useful for applying treating liquid, such as a permanent waving lotion, to hair and that Kellett is concerned with a hair styling brush that includes a foam pad that can be used for applying coloring materials to hair. However, the question before us is not restricted to whether the applicator of Lerner includes protruding members (14) or the brush of Kellett includes tines (5) that are capable of penetrating the scalp, as focused on by appellants (brief, pages 6-9). Concerning this matter, representative appealed claim 1 does not require protrusions capable of penetrating the scalp. As correctly determined by the examiner, the capability of penetrating the outer surface of a plant is sufficient for the tines (5) of Kellett or the members

(14) of Lerner to meet the requirements of the protrusions specified in representative claim 1.

Implicit in the examiner's factual findings, with which we agree, is the determination that the brush tines (5) of Kellett or the members (14) of Lerner are of sufficient stiffness or rigidity and sized to penetrate wound hair or move through hair for brushing and for application of treating liquid or hair coloring. See, e.g., column 15, lines 35-56 of Kellett. Those factual findings are sufficient to establish, prima facie, that those prior art tines and members would have been necessarily capable of penetrating the relatively soft outer surfaces of some plants, including the outer surfaces of ripening tomatoes, grapes and/or other soft fruit surfaces.

It follows that we agree with the examiner that the infusion members (14, fig. 2) of Lerner or the tines (5, fig. 2) of Kellett are constructed in such a manner as to possess the here claimed protrusions' characteristics. Thus, the examiner has established a prima facie case of anticipation by pointing out where all of the claim limitations are described in a single reference. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ

136, 138-39 (Fed. Cir. 1986). Consequently, we will sustain the examiner's § 102(b) rejections.

Rejection under 35 U.S.C. § 103(a)

With regard to the examiner's § 103(a) rejection of dependent claim 12 over Lerner taken together with Gerstel, the examiner asserts that (answer, page 4):

it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Gerstel's protrusion configuration into Lerner's protrusions. Doing so would have improved the protrusion with the addition of cutting edges, and their piercing effect.

However, we note that Lerner is concerned with an applicator for applying liquid to hair and Gerstel provides for a drug delivering device. Against that background, the examiner has not reasonably established why one of ordinary skill in the art would look to Gerstel for a modification of the hair treatment applicator of Lerner.

It is well settled that the mere fact that prior art may be modified to reflect features of the claimed invention does not make the modification obvious unless the desirability of such modification is suggested by the prior art. Our reviewing court has repeatedly cautioned against employing hindsight by using the appellants' disclosure as a blueprint to reconstruct the claimed

invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). From our perspective, the examiner's proposed combination of Lerner and Gerstel appears to be premised on impermissible hindsight reasoning. Thus, we will not sustain the stated § 103(a) rejection.

CONCLUSION

The decision of the examiner to reject claims 1-5, 10, 11, 14, 15, 18-20, 28 and 29 under 35 U.S.C. § 102(b) as being anticipated by Lerner and to reject claims 1, 8, 10, 11 and 18-21 under 35 U.S.C. § 102(b) as being anticipated by Kellett is affirmed. The decision of the examiner to reject claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Lerner in view of Gerstel is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN PART


PAUL LIEBERMAN
Administrative Patent Judge


PETER F. KRATZ
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge

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